

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-31 are pending.

II. The Present Amendment

No new matter has been introduced by the present amendments.

The amendments to the specification correct obvious typographical errors and correct what would otherwise be an active hyperlink when the specification is placed on-line. With regard to the correction of the paragraph beginning on page 4, line 27, Applicants note that the discussion concerns water that is 90% or more pure, and the percentages at the end of the paragraph therefore clearly refer to the percentage of contaminants (impurities) present in the 90% or more pure water, with lower percentages of impurities being more preferred. The amendment to the Abstract brings it into better conformity with the invention as claimed.

The amendment to claim 1 adds a recitation that the method increases the bowl life of the cereal product. This recitation is supported throughout the specification, including page 7, line 31 to page 8, line 17. The amendment to claim 21 adds a recitation that the nut is not boiled by contacting it with water and that the drying of the nut to its original water content is commenced promptly after contacting with water. The recitation regarding boiling is supported throughout the specification, including page 12, lines 6-9. That the drying of the nut commences promptly after the nut is wetted is supported throughout the specification, including page 12, lines 16-20 (e.g., residual heat in the nut from cooking can only facilitate evaporation of water after the contacting step only if the drying commences while the nut is still warm).

Applicants note for the record that the amendment to claim 1 is made for reasons related to clarity of the claim and not to overcome any rejection over the art.

III. The Office Action

Applicants note with appreciation the Action's acknowledgement that claims 22, and 25-30 would be allowable if rewritten in independent form.

Claims 1-21, 23, 24, and 31 are rejected on several grounds. Applicants amend in part and traverse the rejections. For clarity, the rejections are responded to below in the order in which they are presented in the Action.

A. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Action, it is unclear what particular aspect of "improving" is meant. Claim 1 has been amended to recite increasing bowl life of a cereal product, as helpfully suggested by the Action. The amendment is believed to obviate the rejection.

B. Rejections under 35 U.S.C. § 112, first paragraph

1. Rejection of claims 1 and 4-20 as not enabled

Claim 1 and 4-20 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. According to the Action, the specification is enabled for spraying or misting the food, but "does not reasonably provide enablement for any and all methods of hydration." Action, at page 2. The Action further alleges that the specification is not written so as to convey that the inventors had possession of the invention at the time of filing. According to the Action, "the specification, while being enabling for spray[ing] or misting the food, does not reasonably provide enablement for any and all amounts of hydration." Action, at page 2. Applicants amend in part and traverse.

(a). Contention that the specification is enabled for spraying or misting but not for other methods of hydration.

As noted, claims 1 and 4-20 are rejected because the specification is allegedly enabled for spraying or misting, but not "for any and all amounts of hydration." Action, at page 2. Applicants traverse.

(i.) The Action does not present a *prima facie* case of lack of enablement

According to the MPEP, the standard for determining whether a specification meets the enablement requirement is whether a person of skill in the art can make and use the

invention from the disclosure in the specification and the information known to persons in the art, without undue experimentation. MPEP §2164.01. The test is not whether any experimentation is necessary, but whether it is "undue." *Id.* The MPEP reminds the examining corps that "the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." MPEP § 2164.04. The MPEP further reminds the examining corps that, under the court's decision in *In re Marzocchi*, 169 USPQ 367, 370 (CCPA 1971), the Patent Office has the burden to state not only "*why* it doubts the truth or accuracy of any statement in a supporting disclosure," but also "to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." MPEP § 2164.04, *quoting In re Marzocchi, supra*, at page 370 (emphasis in original).

Applicants respectfully submit that the rejection under § 112, first paragraph fails to meet this standard. The Action does not present reasoning or evidence inconsistent with the contested statements. It simply asserts that the specification "does not reasonably provide enablement for any and all amounts of hydration." Action, at page 2. Applicants respectfully note that this is not a reason, but a conclusion. The Action does not show, for example, that there is unpredictability in the art or that persons of skill would not be able to practice the invention without undue experimentation. The unsupported assertion set forth in the present rejection is simply not sufficient to meet the examiner's burden. If they were, *Marzocchi* and MPEP § 2164.04 would be meaningless, since in every case an examiner could meet his or her burden simply by making an unsupported assertion of unpredictability. In the words of *Marzocchi*, "there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure" if the Office could defeat the specification by such a simple expedient.

Whether or not experimentation is "undue" is determined under criteria that were articulated by the Federal Circuit in *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Those criteria are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount

of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The present Action does not acknowledge the *Wands* factors, and does not contain any analysis of why the claims are allegedly not enabled in light of the present specification and the knowledge in the art. Applicants respectfully maintain that application of the *Wands* criteria to the present claims would show that persons of skill in the art were fully enabled to use the invention as claimed without undue experimentation.

(ii.) Spraying and Misting are not Amounts of Hydration, but Methods of Hydration

Applicants respectfully note that spraying and misting are not amounts of hydration, but are instead methods of hydration. The specification makes clear that what is desired is to wet the surface of the cereal product, chip, or freeze-dried food briefly to hydrate the surface, without significant hydration of the interior, see, specification at page 9, lines 13-18, and describes a simple test by which the practitioner can tell if significant hydration of the interior has occurred (the cereal product, chip, or freeze-dried food "collapses;" that is, it becomes soft and visibly loses rigidity. *Id.*) Accordingly, Applicants maintain that the specification enables the hydration of the food product by any means.

The question of whether the food product is over-hydrated, resulting in the collapse of the product, is not a question of the method used, but of the time of exposure. Brief reflection will convince the reviewer that too long a spray of water would result in an over-hydration of an object as easily as would too long an immersion in water. And, in fact, the specification indicates that misting and spraying are preferred since they permit control over how much water is applied per unit time, while immersion or pouring water over the food is less preferred since it is harder to avoid over-hydrating the product. Specification, at page 9, lines 24-28. But, this does not mean that immersion or pouring water cannot be used or are somehow not enabled. The specification teaches that "[t]he correct amount of water and time of application is easily determined empirically and will depend in part on the porosity of the

particular product, chip or freeze-dried food treated, the temperature of the water and the method of contacting." Specification, at page 9, lines 21-23.

Applicants respectfully maintain that the teachings of the specification provide more than adequate guidance to the person of skill in how to use any particular method of hydration of a food product to practice the invention without over-hydrating the product. The application provides a simple test, and the Action has provided no evidence that applying moisture to a food product is unpredictable, or that any experimentation that might be required is undue. Applicants therefore respectfully maintain that the Action fails to set forth a prima facie case of lack of enablement. The rejection of the claims under 35 U.S.C. § 112, first paragraph should be reconsidered and, Applicants respectfully maintain, withdrawn.

2. Rejection of Claims 1-20 for lack of Written Description

Claim 1-20 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. According to the Action, the specification does not show that the inventors had possession of the claimed invention. The Action asserts that:

the extent of hydration contemplated for a good result is not set forth in the specification. One of ordinary skill in the art would have been left to guess what is meant by the recitation 'over-hydrated' in describing what too much water is. Also there are no examples in the specification to show an improved cereal or an improved potato chip or an improved freeze-dried product. Surely it would not have required too much experimentation to show one or two examples of the better product relative to the unimproved one. . . . The terms bowl-life and friability are not defined well enough in the specification at page 4 for one of ordinary skill, who relies on the written word. "Bowl-life" depends upon the meaning of the phrase "unappetizingly soggy", which is a subjective determination that has no tested support in the specification

and examples. The term "friability" depends upon the meaning of the phrase "the tendency of a composition to crumble or break". Surely, some examples of treated and non-treated product could have aided in demonstrating this property. These tests are described in the specification at page 7 but no actual tests were done.

Action, at pages 3-4. Applicants traverse the rejection. For the reader's convenience, the different parts of the rejection are set forth and responded to below.

(a). The Action Does not Meet the Burden Placed on the Examiner to Present A *Prima Facie* Case of Lack of Written Description

As a threshold matter, Applicants maintain that the Action does not comport with the requirements imposed on the Examiner by the MPEP and the courts. The MPEP instructs the Examining Corps that:

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257,263, 191 USPQ 90, 97 (CCPA 1976) ('we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims').

MPEP § 2163 "Guidelines for the Examination of Patent Applications Under the 35 U.S.C. § 112, para. 1, "Written Description" Requirement [R-1], Part I. A, Original Claims, page 2100-160 (emphasis added). Accordingly, the Examiner has the initial burden to present evidence or reasoning to show a person of skill would not recognize a disclosure of the invention as claimed. "Consequently, rejection of an original claim for lack of written description should be rare." MPEP § 2163 Part II. A, page 2100-163.

The Action does not meet this burden. The Action presents no evidence or reasoning showing that persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. In its place, the Action merely asserts that certain terms are not sufficiently defined (which would be better posed as an indefiniteness rejection) and that there are no comparative examples (which is both incorrect, as noted above, and irrelevant, since there is no requirement in the law to provide examples). In short, the Action fails to present the evidence required to support a prima facie case of lack of written description. It should be reconsidered, and withdrawn.

(b). The Specification Presents a Comparative Example Showing Possession of the Invention at the Time of Filing

The written description rejection is further in error because the specification shows an actual reduction to practice, demonstrating that the inventors had possession of the invention as claimed. While the specification does not provide a detailed Example regarding the differences between a breakfast cereal flake treated by the methods of the invention and one without, it does report on the results of such a study:

Exemplary tests of the method on breakfast cereal flakes have shown decreases of up to 70% in the amount of cereal that is broken during the test compared to flakes of the same cereal that have not undergone treatment with the method.

Specification, at page 5, lines 19-21.

Accordingly, the specification does present the results of a comparative study. The reported results show that the inventors had possession of the invention "by describing an actual reduction to practice of the claimed invention." MPEP 2163, Part II 3 (a), page 2100-165. Applicants respectfully note that the Action sets forth no reasoning or evidence that the methods of the invention would not provide the same results for chips and for freeze-dried foods as they did for cereal products.

Accordingly, Applicants respectfully maintain that the specification shows that the inventors had possession of the invention at the time of filing. The written description rejection should be reconsidered, and withdrawn.

(c). Contention Regarding Leaving Cereal Out in the Rain

The Action contends that, in the absence of a comparative example, the claims "merely suggest a process wherein a consumer leaves his cereal out in the rain and then that it tastes better when he consumes it [then when he eats it] on a sunny day." Action, at page 4. As shown in the preceding section, the specification provides the results of a comparative example, as requested by the Action. Applicants also respectfully note that leaving a bowl of cereal out in the rain would likely result in significant hydration of the interior of the cereal, resulting in "collapse" of the cereal, as described in the specification at page 9, lines 18-20. For this reason, the specification indicates that the contacting with water should be brief (*id.*, at lines 15-16), and that correct amount of water can be easily determined empirically. *Id.*, at lines 21-23. Thus, the hypothetical envisioned by the Action is unlikely to result in the invention as claimed. In any event, the hypothetical does not constitute evidence that the inventors did not possess the invention as of the time of filing, as required to support the rejection for lack of written description.

(d). The Rejection Rejects the Claims for a Recitation that is not Present in the Claims, and for allegedly not defining a term that is in fact defined

As noted in the beginning of this section, the rejection rejects the claims in part because, allegedly, one of skill would be "left to guess what is meant by the recitation "over-hydrate.

As an initial matter, the rejection appears to reject the claims for a recitation that is not present in them. Claims 1-20 do not contain a recitation using the term "over-hydration." Thus, even if the rejection was otherwise correct, which is not conceded, it is not clear why a it would have any bearing on whether or not the inventors had possession of the invention at the time of filing.

Even assuming, however, that a test for over-hydration is required, one is set forth in the specification. Page 9, lines 13-18 of the specification describe a simple test by which the practitioner can tell if over-hydration of the food has occurred: "the product, chip, or [freeze-dried] food 'collapses,' that is, it becomes soft and visibly loses rigidity or flattens." The person of skill can therefore readily determine whether over-hydration has occurred following the teachings of the specification.

Accordingly, contrary to the assertions of the Action, the person of skill is not "left to guess" what constitutes 'over-hydration.' Instead, the practitioner is provided a simple test to determine visually whether over-hydration has occurred. Thus, while the term appears to be legally irrelevant to whether or not there is an adequate written description to support the claims, there is more than sufficient teaching in the specification for a person in the art to determine whether or not any particular food product is over-hydrated.

(e). Concern Over "the perimeters of the term 'improving'"

The Action asserts that the "perimeters of the term 'improving' [are] not fully set forth in the specification." Action, at page 3. This concern has been obviated by the amendment to claim 1. For the sake of good order, Applicants also note that this aspect of the rejection did not apply in any event to claims 16-20, which did not and do not contain the word "improving."

(f). Concerns over the terms "Bowl Life" and "Friability"

The Action contends that the "terms bowl-life and friability are not defined well enough in the specification at page 4 for one of ordinary skill in the art, who relies on the written word. 'Bowl-life' depends upon the meaning of the phrase 'unappetisingly soggy', which is a subjective determination that has no tested support in the specification and examples. The term 'friability' depends upon the meaning of the phrase 'the tendency of a composition to crumble or break.' " Action at page 4.

As an initial matter, Applicants observe that this portion of the rejection is not properly posed as a written description rejection. It does not speak to whether the inventors had possession of the invention, but rather whether the terms used are sufficiently definite, and

therefore should be posed, if at all, as a rejection for indefiniteness. The rejection will therefore be analyzed under the standard appropriate for evaluating definiteness.

(i). The Standard for Judging Definiteness

The MPEP provides a specific standard which the examining corps is to use in judging definiteness. The Examiner's attention is respectfully drawn to MPEP § 2173.02.

Section 2173.02 instructs that claims should be allowed which

define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even if the claim language is not as precise as the Examiner might wish.

MPEP at page 2100-198 to page 2100-199, bridging paragraph (emphasis in original). Further, § 2173.02 gives the Examining Corps the following instructions:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art as of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 second paragraph by providing clear warning to others as to what constitutes infringement of the patent.

MPEP §2173.02, at page 2100-199 (emphasis added).

(ii) The MPEP's analysis has not been followed with regard to the present rejection

Applicants respectfully observe that the Action's concerns regarding the words "bowl-life" and "friability" are not based on the analysis required by the MPEP. The rejection quoted above, rests on the subjectivity of the words. But, the rejection does not reflect, and does not contain, the required analysis of the teachings of the specification, the teachings of the prior art, or the interpretation that would be given the claims by a person of ordinary skill in the art. The rejection is therefore not based on the analysis required by the MPEP before a proper rejection for indefiniteness can be made. Applicants respectfully maintain that following the standard set forth in the MPEP results in the conclusion that the claims define the invention with the reasonable degree of clarity and particularity required.

Applicants turn first to the Action's concern regarding the term "bowl life." For the sake of good order, Applicants note that this aspect of the rejection applies only to claims 1-15, since claims 16-20 are drawn to reducing friability, not to increasing bowl life. The Action provides no analysis or reasoning why a person of ordinary skill in the art, typically a food scientist, would be unable to determine what constitutes "bowl life." In particular, the Action does not indicate the interpretation that would be given to the term by a person of ordinary skill or why that interpretation would be deficient in giving notice as to what would constitute infringement of the patent.

The Action's concern rests on the subjective nature of whether a cereal has become soggy. But, as noted quoted above, MPEP §2173.02 requires only a reasonable degree of clarity and particularity. Practitioners in the art are accustomed to determining the bowl life of a cereal product, as reflected by the fact that manufacturers currently apply high amylose starch and other specialty starches to improve this characteristic, specification at pages 7-8, bridging paragraph, and manifestly routinely determine if the amount of starch added is sufficient to achieve whatever degree of improvement in bowl life is desired. The Action sets forth no evidence or reasoning why persons of skill in the art would suddenly lose the capacity to

judge bowl life in following the teachings of the present specification. Further, the Action contains no analysis demonstrating that the teachings set forth in the specification are insufficient or would not be capable of appropriate interpretation by persons of skill in the art. Applicants respectfully note that this is not a highly technical area in which detailed guidance is needed. Applicants respectfully maintain that the average consumer is readily able to determine whether any particular bowl of cereal is "unappetizingly soggy." And, finally, even if there was some ambiguity, which Applicants do not concede, MPEP §2173.02 instructs the Examining Corps that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even if the claim language is not as precise as the Examiner might wish."

The Action fares no better with regard to the term "friability." For the sake of good order, Applicants note that this aspect of the rejection applies only to claims 16-20, since claims 1-15 are drawn to increasing bowl life, not to reducing friability. Once again, the Action contains no analysis demonstrating that the teachings set forth in the specification are insufficient or would not be capable of appropriate interpretation by persons of skill in the art. For this reason alone, the rejection fails to meet the standard articulated by the MPEP. The Action's only support for its concern is that the specification sets forth tests for friability at page 7, but that no actual tests were done. As noted above, this is incorrect, since a comparative test was done and its results reported in the specification. But, whether or not tests were actually done is unnecessary to support the definiteness of the language. Friability determinations are routinely made by persons in the art, as evidenced by the citation of commercially available equipment to make measurements of friability. And, finally, as noted above, even if there was some ambiguity, which Applicants do not concede, MPEP §2173.02 instructs the Examining Corps that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even if the claim language is not as precise as the Examiner might wish."

Accordingly, the Action fails to set forth a prima facie case of indefiniteness with respect to either "bowl life" or "friability." The rejection, to the extent it constitutes an indefiniteness rejection over the use of these terms, does not meet the standard set forth in the MPEP, and should be withdrawn.

C. Rejection of Claims 16-20 Under 35 U.S.C. § 103(a)

Claims 16-20 are rejected under 35 U.S.C. § 103(a) as obvious over Bailey, U.S. Patent No. 2,761,781 ("Bailey"). According to the Action:

Bailey discloses a method of making nut kernels friable. Here, nuts are treated with water at a temperature of 32-102F . . . and then dried. The claims appear to differ from the reference in the suggestion that the product is a potato chip or a freeze-dried food. But the same acts in the same relationship are seen to produce the same result.

Applicants traverse.

As noted by the Action, Bailey discloses a method of making nuts friable, that is, of making them easier to break into smaller pieces. The present invention is directed at making chips and freeze-dried foods less friable, that is, to making them less susceptible to being broken into pieces. Contrary to the basis of the rejection, therefore, the present invention is directed to a result directly the opposite that of the result to be achieved by Bailey. Rather than producing the same results, therefore, the practitioner looking at Bailey would see a teaching away from using the method of Bailey to achieve a reduced friability. As the Examiner will appreciate, "teaching away" by a reference is the opposite of rendering the invention obvious.

In Bailey, the nuts are wetted to render the outer layer of the kernel temporarily stretchable and provides a temporarily relatively tough outer coat within which the interior fiber of the kernel may be fractured. Bailey, at column 3, lines 4-9. Following the wetting, the nuts can optionally undergo a surface or superficial drying. *Id.*, at lines 10-28. It is this drying that the Action maintains demonstrates "the same acts in the same relationship." But, the surface drying in Bailey must be "sufficient only to remove excess moisture from the pellicle without removing the moisture from the stretchable outer layer." Bailey, at column 3, lines 10-16. Thus, the nut is not dried back to its original water content, as recited by claim 16, but is left moist. Moreover, Bailey cannot be modified to produce the present invention. Drying the nut to its original water content would remove the temporarily tough outer shell provided by the wetting of

the nut, which is the whole point of wetting the nut in the first place. MPEP § 2143.01 prohibits modifying a reference in a way that renders the prior art unsatisfactory for its intended purpose.

In short, Bailey teaches away from the method as claimed in claims 16-20. Moreover, Bailey cannot be modified to suggest the present invention without rendering it unsatisfactory for its intended purpose. Accordingly, claims 16-20 are not obvious over Bailey. The rejection of claims 16-20 as obvious over Bailey should be reconsidered and withdrawn.

D. Rejection of Claims 21, 23, 24, and 31 Under 35 U.S.C. § 102(e)

Claims 21, 23, 24, and 31 are rejected under 35 U.S.C. § 102(e) as anticipated by Gorang, U.S. Patent No. 6,572,907 ("Gorang"). The rejection presents no argument supporting this contention, but merely points to the abstract and portions of the text. Applicants amend in part and traverse.

The method of Gorang requires that the nuts be blanched for 3 to 5 minutes to stop enzymatic activity. See, Abstract. Gorang explains that the blanching begins by adding shelled walnuts to "atmospheric boiling water" at 210 °F to 212 °F and maintaining the nuts at approximately boiling water temperature for 3 to 5 minutes. Gorang, at column 5, lines 24-28. To expedite prosecution, claim 21 has been amended to recite that the nut is not boiled by the water. Since Gorang depends on blanching the nut in boiling water to stop enzymatic activity, it neither teaches nor suggests that use of water at a temperature below the boiling point. Accordingly, it neither teaches nor suggests the invention as now claimed. Moreover, since claims 23, 24, and 31 are dependent on claim 21, the amendment to claim 21 also renders these claims free of the rejection as well.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Appl. No. 09/879,794
Amdt. dated 04/06/2004
Reply to Office Action of October 6,2003

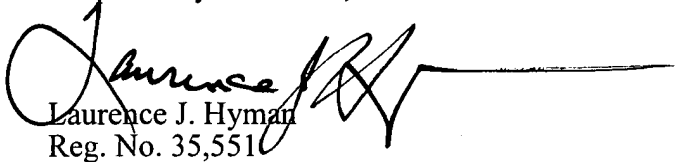
PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, she is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,


Laurence J. Hyman
Reg. No. 35,551

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
LJH:ljh
60184741 v1